

REMARK

In response to the Final Office Action dated June 18, 2003, Applicants have amended claim 1 to revise wording for clarifying the scope of the claim, together with filing a Request for Continued Examination. Adequate descriptive support for the amendment can be found in, for example, Fig. 2. Care has been exercised to avoid the introduction of new matter.

Applicants acknowledge, with appreciation, the Examiner's allowance of claims 5-8. Now, claims 1-13 are active in this application.

Claims 1-2 and 4 have been rejected under 35 U.S.C. §102(b) as being anticipated by Ohki et al.

In the statement of the rejection, the Examiner asserted that Ohki et al. discloses a multi-chip semiconductor device identically corresponding to what is claimed. This rejection is respectfully traversed.

In response, Applicants have amended claim 1 to revise wording to clearly define the structure of the outer leads, which "extend at least from a plane including the lower surface of the sealing member to beyond that of the upper surface of the sealing member." Based on this Amendment, Applicants submit that Ohki et al. does not disclose all the limitations recited in claim 1.

As the Examiner pointed out, Ohki et al. discloses outer leads 237 shown in Fig. 22. However, unlike the outer leads of the claimed invention, it is apparent that Ohki's outer leads 237 do not extend at least from a plain including the lower surface (the surface facing a heat sink 236) of the sealing member 235.

Accordingly, Ohki et al. does not disclose all the limitations recited in claim 1, and does not have identical disclosure of each element of the claimed invention in the meaning of 35 U.S.C. §102. *See Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Applicants therefore solicit withdrawal of the rejection of claims 1.

Moreover, a dependent claim is not anticipated if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claim. Therefore, **claims 2 and 4** are also patentable because they respectively include all the limitations of independent claim 1. Applicants respectfully traverse the rejections of those claims and solicit withdrawal thereof.

Claims 3 and 9-13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Ohki et al.

As to **claim 3**, the Examiner asserted that it would have been obvious to form the outer leads on the four sides of the sealing member. In response, Applicants submit that claim 3 should be allowed because it depends on claim 1 which is patentable for the reason set forth above. Specifically, the Federal Circuit held that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully solicit withdrawal of the rejection of claim 3.

With respect to **claim 9**, the Examiner admitted that Ohki et al. differ from the claimed invention because Ohki et al. does not show a plurality of semiconductor

packages mounted on a printed wiring board. Nevertheless, the Examiner concluded that it would have been obvious to have a plurality of semiconductor packages mounted on the printed wiring board because a plurality of similar devices may be used to form a desired circuit on a printed wiring board. To support his reasoning, the Examiner further asserted that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

In response, Applicants submit that in the claimed invention, the plurality of semiconductor packages are not mere duplication. The following is reproduction of relevant portions from claim 9.

a plurality of semiconductor packages mounted on the printed wiring board, each semiconductor package having **an upper surface of a sealing member thereof facing the printed wiring board** and outer leads thereof connected to electrodes formed on the printed wiring board; wherein each of the plurality of semiconductor packages comprises, ...

the sealing member sealing therein the die, the bonding wires, parts of the outer leads and a part of the die pad, and having **the upper surface on the side of the die** and a lower surface on the side of the die pad; ...

It is apparent that the plurality of semiconductor packages are not arbitrarily arranged in the claimed invention, but claim 9 clearly defines orientation of the semiconductor packages with respect to how to mount them on the printed wiring board. Specifically, claim 9 describes that each semiconductor package is mounted on the printed wiring board such that the upper surface of the sealing member thereof faces the printed wiring board. The upper surface of the sealing member in claim 9 is a surface on the side of the die. Applicants submit that such clear recitation in claim 9 cannot allow the Examiner to automatically determine that claim 9 recites mere duplication of parts. This is so because Ohki et al. does not disclose a plurality of semiconductor packages mounted on a printed

wiring board with such orientation. Therefore, the Examiner's assertion with respect to claim 9 is unreasonable.

Thus, consideration of the teachings of Ohki et al. would not have suggested each and every limitation of claim 9. In the instant case, the pending rejection has not established *prima facie* obviousness of the claimed invention as recited in claim 9, because Ohki et al. fails to satisfy the all the claim limitations standard required under §103. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In other words, Ohki et al. does not show a plurality of semiconductor packages mounted on the printed wiring board, as the Examiner admitted in the Office Action. Applicant, therefore, solicits withdrawal of the rejection of claim 9.

Moreover, dependent **claims 10-13** which respectively depend from claim 9 are also patentable because if an independent claim (claim 9) is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants solicit withdrawal of the rejection of claims 10-13.

Conclusion.

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

09/915,366

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Stephen A. Becker
Registration No. 26,527

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SAB:TT
Facsimile: (202) 756-8087
Date: September 18, 2003